

REMARKS/ARGUMENT

Claims 1-42 and 61-66 are pending in the above-referenced application. Claims 1-4, 12, 23, 32, 35-37, and 39-41 have been amended. Claims 64-66 have been added. Claims 43-60 were canceled without prejudice in response to a previous restriction requirement. No new matter has been added.

Support for the claim amendments and new claims can be found, for example, in paragraphs [0044], [0049], and [0119] of pre-grant publication US 2004/0153408.

Obviousness Rejection Based on Brown in view of Applicant's Prior Art

The July 21, 2008 final Office action rejects claims 1-3, 6-7, 9, and 10-11 under 35 U.S.C. § 103(a) as being unpatentable over Brown *et al.* U.S. Patent No. 6,550,671 ("Brown") in view of Applicants' alleged admitted prior art ("prior art"). Claims 4, 8, and 61 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown and Applicants' prior art in further view of Yang *et al.* U.S. Patent No. 6,516,078 ("Yang"). Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown and Applicants' prior art in further view of Thompson U.S. Patent No. 5,530,773 ("Thompson"). Claims 12-42 and 62-63 are rejected using analogous reasoning given to claims 1-11 and 61. These rejection are respectfully traversed.

Brown describes an improved cash register and method of operating a cash register that accounts for both cash received into and dispensed from a cash register. *See, e.g.*, Abstract; FIG. 4; column 1, lines 7-10; column 5, lines 7-21; column 9, lines 23-45. Brown also describes a transaction database for recording transactions (column 5, line 35) and a transaction report that may be communicated to a customer's PC (column 7, lines 18-22). It is noteworthy that the citations to Brown do not recite a system, processor, or method for receiving documents associated with a deposit or deposit transaction being made at a financial institution, as generally recited in each of independent claims 1, 12, 23 and 32. That is, Brown's disclosure appears limited to cash registers and point-of-sale of transactions by purchasers. *See* Abstract; column 5, lines 7-21. Furthermore, Brown fails to teach automatically generating a government-required report.

The reliance of the Office action on the Applicants' specification does not overcome the deficiencies of Brown. The Applicants' specification recites that "[i]t is well known that information obtained from various financial documents, including currency bills, as they enter and leave a financial institution, may be useful in various automated operations within the institution, if that information may be retrieved". The Applicants further recite:

Based upon the foregoing there is a **great need** to have a system that is capable of monitoring all deposits made at a financial institution and **automatically generating** the required report whenever the total value of a cash deposit exceeds the threshold value prescribed by the laws of the country in which that facility is located.

See US 2004/0153408, ¶¶ [0005]-[0006] (emphasis added). That is, the Applicants' specification recites a need for a system capable of automatically generating a required report.

Independent Claim 1

Amended independent claim 1 recites, *inter alia*, "in the document processing device, automatically generating a government-required report whenever the accumulated total value exceeds a prescribed value." As stated in the Office action, Brown "fails to teach generating a government-required report whenever the accumulated total value exceeds a prescribed value." Page 4. Furthermore, Brown does not recite a method for receiving a plurality of documents associated with a deposit being made at a financial institution.

The reliance on the Applicants' specification is misplaced and does not overcome the deficiencies of Brown. While the Applicants' specification recites that "the laws of various countries require banks and other financial institutions to report to the governments of such countries any cash deposits in excess of a prescribed value" (¶ [0005]), the Applicants also specifically disclose "a **great need** to have a system that is capable of monitoring all deposits made at a financial institution and automatically generating the required report". That is, neither Brown nor that apparent reliance on paragraph [0005] of the pre-grant publication of the present application, alone or in combination, discloses, teaches, or suggests automatically generating a government-required report, as recited in amended claim 1.

For at least these reasons, amended independent claim 1 is not rendered obvious by Brown, Applicants' prior art, or any combination thereof. Thus, amended claim 1 should be in a condition for allowance.

Independent Claims 12, 23, and 32

Amended independent claims 12, 23, and 32 each contain the following respective elements, which have similarities to the amendment described above for independent claim 1:

- (i) Amended claim 12 recites, *inter alia*, a system comprising “a generating device for **automatically generating** a government-required report whenever the accumulated total value exceeds a prescribed value”;
- (ii) Amended claim 23 recites, *inter alia*, a document processor comprising “a processor programmed to accumulate the total value of the currency bills included in each deposit, and to **automatically generate** a government-required report whenever the accumulated total value exceeds a prescribed value”; and
- (iii) Amended claim 32 recites, *inter alia*, a method comprising “**automatically generating and printing** a government-required report whenever the accumulated total value exceeds a prescribed value.”

Neither Brown nor the apparent reliance on paragraph [0005] of the pre-grant publication of the present application, alone or in combination, discloses, teaches, or suggests automatically generating or automatically generating and printing a government-required report, as recited in amended claims 12, 23, or 32. For at least these reasons, amended independent claims 12, 23, and 32 are not and cannot be rendered obvious by Brown, Applicants' prior art, or any combination thereof. Thus, amended claims 12, 23, and 32 should be in a condition for allowance.

Dependent claims 2-11, 13-22, 24-31, 33-42, and 61-63

Claims 2-11, 13-22, 24-31, 33-42, and 61-63 depend either directly or indirectly from amended independent claims 1, 12, 23, or 32. For at least the reasons discussed above for amended claims 1, 12, 23, and 32, their respective dependent claims are not and cannot be

rendered obvious based on Brown, Applicants' prior art, Cahill, Thompson, or any combination thereof. Thus, claims 2-11, 13-22, 24-31, 33-42, and 61-63 are in a condition for allowance.

Furthermore, it appears that the final Office action is still taking Official Notice for dependent claims 10, 11, 20, 21, 24, 25, 33, and 34. The Office action states that supporting art will be provided (*see* p. 2), however, no support is put forth other than asserting that it would be obvious to one of ordinary skill in the art to increase or decrease the rate at which documents are processed. The Applicants disagree and continue to point out that the self-serving assertion of the Office action in no way discloses or suggests transporting a plurality of documents and denominating the plurality of documents at a rate in excess of 800 documents per minute or 1,000 documents per minute, as recited, for example, in claims 10 or 11.

Brown fails to disclose a processing speed for transporting and denominating documents. Moreover, a motivation or desire for faster processing speed does not provide that such document processing rates have been achieved or are commonly known. At best, the final Office action improperly asserts that because one would wish or desire to achieve the claimed document processing rates, it must already be achieved or known. In fact, contrary to the apparent assertion of Official Notice, Brown suggests much slower processing rates since Brown's system is used with a cash register. Specifically, Brown discloses:

The method of the present invention enables a business to automatically determine the amount of money received into and dispensed from a cash register during any given time period. This determination is done by adding the denominations of all bills received into and retained within the cash register during a selected time period, and subtracting from that amount the denominations of bills that were dispensed from the cash register during the selected time period.

Column 6, lines 28-35 (emphasis added).

That is, the emphasized time period in Brown suggests much slower processing rates than what is claimed, for example, in claims 10 and 11.

To the extent the Office action is relying on Official Notice, the Applicants again note that Official Notice "unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are

capable of instant and unquestionable demonstration as being well-known.” MPEP § 2144.03, p. 2100-145 (8th Ed., Rev. 6, Sept. 2007). The “applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice so as to adequately traverse the rejection in the next reply after the Official action in which the common knowledge statement is made.” MPEP § 2144.03, p. 2100-146. However, as discussed above, the final Office action does not provide any support for transporting and denominating a plurality of documents at a rate in excess of 800 or 1,000 documents per minute. For at least these additional reasons, claims 10, 11, 20, 21, 24, 25, 33, and 34 should further be in a condition for allowance.

In addition, dependent claim 8 recites, “storing the electronic data so that images of the documents may be retrieved and displayed for review at a time subsequent to completion of the deposit.” Dependent claim 61 depends from claim 8. Dependent claims 18, 26, 62, and 63 contain similar elements. The final Office action states that “Brown fails to further teaches storing the electronic data so that images of the documents may be retrieved and displayed for review at a time subsequent to completion of the deposit.” Page 9. The final Office action then improperly alleges that certain citations from Yang teaches this element. The Applicants disagree. Yang is directed to a copy machine capable of detecting and deterring the printing of counterfeit documents by denying printing or printing a selectively deteriorated copy document. *See* Abstract. That is, the citations to Yang **fail** to disclose, teach, or suggest storing electronic data. Thus, for at least these additional reasons, dependent claims 8, 18, 26, and 61-63 should further be in a condition for allowance.

New Claims 64-66

New dependent claim 64 recites, “automatically generating a government-required report in response to dispensing at least one currency bill having a specified serial number.” New dependent claim 65 recites, “automatically generating a government-required report in response to dispensing at least one currency bill having a specified denomination.” New dependent claim 66 recites, “wherein the specified denomination at least includes one-hundred-dollar bills.” Both Brown and the Applicants’ prior art fail to disclose any of these elements. Thus, for the reasons discussed above in connection with independent claim 1 and for these additional reasons, dependent claims 64-66 are in a condition for allowance.

CONCLUSION

The Applicants submit that claims 1-42 and 61-66 are in condition for allowance and action toward that is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at (312) 425-8552.

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It is believed that no additional fees are due; however, should any fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from the Nixon Peabody Deposit Account No. 50-4181, Order No. 247171-000381USPT.

Respectfully submitted,

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